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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,122	11/13/2001	Ronald L. Ream	112703-202	1413
29156	7590	10/14/2003		
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER TRAN, SUSAN T	
			ART UNIT	PAPER NUMBER
			1615	12
DATE MAILED: 10/14/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,122

Applicant(s)

REAM ET AL.

Examiner

Susan Tran

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 08/22/03.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Yotka  
US 5,536,511.

Yotka teaches a chewing gum product comprising a gum pellet cover by hard coating containing from about 1% to about 100% sugar or sugar alcohol to the coating, and the coating maybe about 20% to about 50% of the weight of the finished gum product (see abstract, and column 4, lines 10-24). The chewing gum product comprises elastomer, plasticizers, waxes, emulsifiers, inorganic filler, and softener (column 4, lines 53 through column 5, lines 1-25).

The examiner notes that Yotka does not teach the use of medicament in the coating composition. However, Yotka teaches the use of calcium carbonate or magnesium carbonate, and talc, which are well known minerals in pharmaceutical art. Thus, such language does suggest the use of medicament in the coating since applicants' claims 9 and 16 recite "minerals" as medicament that can be used in the coating.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11, 14-18, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte US 5,578,336.

Monte teaches a soft candy/gum center coated with coating layers containing vitamin and enzyme (see abstract, columns 3-4). The coating further comprises sugar or sugarless sweetener, including xylitol (columns 2-3).

Monte does not teach the weight percent of the coating being at least 50% of the product as claimed in claim 8. However, Monte teaches the coating composition is applied to the gum center in a plurality of coating layers to obtain the thickness desired; or to increase the sealing effect of the resulting coatings to prevent moisture from penetrating the coating and contacting vitamins or enzymes applied to the gum core (column 3, lines 18-23; and example 29). Absent of showing criticality over the claimed amount of at least 50% of the product, it would have been obvious for one of ordinary skill in this art to, by routine experimentation determine a suitable amount of coating to obtain the claimed invention, because the reference teaches the advantageous results in the use of a coating composition to protect the gum center from moisture. The expected result would be a coated chewing gum composition, which, during storage, the

Art Unit: 1615

vitamins and enzymes are protected by a coating composition from biodegradation and decomposition.

Claims 8-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte US 5,578,336, in view of Yotka US 5,536,511.

Monte is relied upon for the reason stated above. Monte is silent as to the teaching of the amount of sugar or sugarless sweetener in the coating composition.

Yotka teaches a chewing gum product comprising a gum pellet covered by hard coating containing from about 1% to about 100% sugar or sugar alcohol to the coating, and the coating may be about 20% to about 50% of the weight of the finished gum product (see abstract, and column 4, lines 10-24). The chewing gum product comprises elastomer, plasticizers, waxes, emulsifiers, inorganic filler, and softener (column 4, lines 53 through column 5, lines 1-25). Thus, it would have been obvious for one of ordinary skill in the art to modify the coating of Monte using suitable amounts of sugar or sugarless sweetener in view of the teaching of Yotka with the expectation of at least similar result, because the references teach the advantageous results in the use of sugar or sugarless in a chewing coating composition.

### ***Response to Arguments***

Applicant's arguments filed 08/22/03 have been fully considered but they are not persuasive.

Applicant argues that the use of calcium carbonate, magnesium carbonate, and talc as disclosed in Yotka is absolutely unrelated to medicaments, but is a stabilizer. Contrary to the applicant's argument, the determination of patentability of the product claims is based on the product itself. In response to applicant's argument that the reference does not show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., medicine or an agent that achieves a desired effect in a consumer of the product) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is noted that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applicant's amendment removed the term "minerals" does not place the application in condition for allowance because, according to the Merck Index, calcium carbonate or magnesium carbonate can be a mineral, an antacid, as well as a dietary supplement. Accordingly, the rejections under 102(b) and 103(a) by Yotka et al. are maintained.

Applicant argues that Monte teaches an intermediate sealing layer between the gum/candy center and the vitamin layer, there is no motivation or suggestion within Monte to have the medicament or vitamin layer in direct contact with the gum center.

Contrary to the applicant's argument, the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981). Thus, the claimed language does not exclude the intermediate layer taught by Monte. In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., medicament or vitamin layer in direct contact with the gum center) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Yotka does not remedy the deficiencies of Monte because Yotka merely relates to a chewing gum product comprising a gum pellet covered by a hard coating. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

Art Unit: 1615

teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Friday from 7:00 am to 5:00 pm.



Art Unit: 1615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600